UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/329,461	06/10/1999	HERMAN RODRIGUEZ	AT9-99-085	8120

7590   12/06/2001

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ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 12/06/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)	
	09/329,461	Rodriguez et al..	
	Examiner	Art Unit	
	Cuong H. Nguyen	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ___3___ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Sep 21, 2001* _____.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-46* _____ is/are pending in the application.

   4a) Of the above, claim(s) *15-24* _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-14 and 25-46* _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

   a) ☐ All b) ☐ Some* c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: _____

DETAILED ACTION

1.   This Office Action is the answer to the response received on 9/21/2001, which paper has been placed of record in the file.

2.   Claims **1-14, 25-46** are pending in this application.

Response to the paper submitted on 7/16/2001:

3.   At first, the examiner submits that **smart-card** has been widely used in transactions, it can do all limitations in pending claims. MS Computer Dictionary (3rd edition, 1997) defines: smart card: a circuit board with built-in logic or firmware that gives it some kind of independent decision-making ability; or **a credit card** that contains an integrated circuit that **gives it a limited amount of "intelligent" and memory**. Therefore, **smart-card's abilities at the time of invention having all claimed abilities.**

4.   Since we are examining utility patents, the claims must be directed to systems, methods or articles of manufacture that have a clear utility. See MPEP 706.03(a) for example. Over the years, numerous court decisions have analyzed the content of various claimed language for meaningful, useful differences in structure or acts performed between the claims and the prior art. Some of these decision have found that certain language adds little, if anything, to the claimed structure or acts and thus do not serve as a limitation on the claims to distinguish over the prior art. For example, language directed to an intended use of dispensing popcorn in a claim for a product

did not result in a structural or functional difference with respect to prior art and were held not to serve as a limitation on the claim. See in re Schreiber, 44 USPQ2d 1429 (CAFC 1997).

Thus, a limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See in re Gulack, 217 USPQ 401 (CAFC 1983), ex parte Carver, 227 USPQ 465 (BdPatApp&Int 1985) and in re Lowry, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

5. During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.

6. The court ruled that a rejection is reasonable if claims' language can be read-on by cited references and no reasonable distinguishing limitation has been made in

claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057

(Fed. Cir. 1993)).

7. *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d

1843 (CA FC 1989), the court ruled:

A reference may be relied upon for all that it would have

reasonably suggested to one having ordinary skill in the

art, including non-preferred embodiments (arguments on

"inventory" subject matters not on cited references).

8. In re **Conrad**, 169 USPQ 170 (CCPA 1971), the court ruled:

The test for obviousness under 35 U.S.C. 103 is not the

express suggestion of the claimed invention in any or all of

the references but what the references taken collectively

would suggest.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which

forms the basis for all obviousness rejections set forth in

this Office action:

    (a) A patent may not be obtained though the invention is not
    identically disclosed or described as set forth in section 102 of
    this title, if the differences between the subject matter sought to
    be patented and the prior art are such that the subject matter as a
    whole would have been obvious at the time the invention was made to
    a person having ordinary skill in the art to which said subject
    matter pertains. Patentability shall not be negated by the manner
    in which the invention was made.

9. Claims **1-14, 25-46** are rejected under 35 U.S.C. 103(a) as

being unpatentable over **Tognazzini** (US Pat. 5,739,512), in

view of the Official Notice.

10. Re. To claim **1/3/5**: **Tognazzini** suggests a method for

conducting a commercial transaction in a distributed data

processing system, the method comprising the steps of:

- recording an electronic receipt **(a digital certificate)** on

a removable storage medium (a smart card, see **Tognazzini,**

the abstract, Fig.6A, 7, 1:47-55, 2:26-28) at a first data

processing terminal, the electronic receipt **(a digital**

certificate) comprising data concerning a commercial

transaction (not patentable);

- receiving the removable storage medium (a smart-card) at a

2nd computer at a different time/~~location~~; (see **Tognazzini,**

Figs.1-2, 6A, 7, 3:16-20; this limitation is not

patentable);

The examiner submits that **Tognazzini** performs

validating an e-**receipt stored on the removable storage**

medium/(a smart-card) at the second computer ~~data processing~~

~~system~~; (see also **Tognazzini for an analogous step of**

"**sending an e-confirmation of the purchase transaction to a**

customer", 3:21-26) not patentable);and

The examiner submits that **Tognazzini** performs checking

digital signatures (validating/integrity determining e-

receipt) to conducting a commercial transaction (see

Tognazzini, the abstract, Figs.4, 7).

The examiner also submits that a validated e-receipt

can be in the form of a digital certificate just because a

document is validated; therefore the Official Notice is

taken that a reference from http://www.findarticles.com

inherently suggests said "validation":

Business Wire - August 26, 1998, VeriSign and Gemplus Expand Strategic Relationship;
To Develop Joint Smart Card/Digital Certificate Solution For Secure Network
Applications.

11. Re. To claim **2** (as claim 4): The method of claim 1 wherein the step of validating the electronic receipt **further** comprises **inspecting a digital signature**. This limitation is similar to an obvious step done by **Tognazzini** "Encryption techniques permit the secure transmission of electronic information. Well-known public/private key encryption schemes provides privacy and content security, while digital signature schemes provide for authentication of the sender. These techniques are well-understood and widely used in many applications, including electronic mail and EDI.". Therefore, this limitation is not patentable.

12. Re. To claim **3** (as claims 1, 5): Besides having several limitations as claims 1,5; this claim further discloses limitations that Tognazzini suggests:

- in response to **validating** an e-receipt,

a. providing an indication to proceed with a delivery of goods/services related to the purchase transaction (see **Tognazzini** 2:28-40; and

b. **updating an inventory** affected by said delivery of goods/services (see **Tognazzini** 2:61-65, 3:4-20, 3:28-38) (this updating step merely a well-known step in marketing business **resulting** from an outstanding order).

13. Re. To claim **4** (as claim 2): The method of claim 3 wherein the step of validating the e-receipt **further** comprises **inspecting a digital signature** to verify the integrity of the electronic receipt. The Official Notice is taken here that a step of inspecting a digital signature has been known. One of ordinary skill in the art would perform

said inspection step as inspecting signature often gives proof for a document.

14. Re. To claim 5 (as claim 1): Besides several similar limitations in claim 1, the Official Notice is taken that the following limitations are known:

- in response to validating the electronic receipt, **providing an indication to proceed** (can be a "Y"/"O.K." signal to continue/follow to next step in business which is well-known: delivery of goods) with a delivery of goods/services related to a purchase transaction.

15. Re. To claim 6 (as claims 3, 5): The method of claim 5 further comprising:

- processing a purchase transaction (as claim 3);
- generating an e-receipt comprising data concerning the purchase transaction (as claim 3); and
- storing the electronic receipt on said removable storage medium (as claim 3);

wherein said removable storage medium **remains with a consumer** (this limitation is not patentable since "remains with a consumer" is an option, the point is "an e-receipt storing in a smart-card").

Therfore, the rationales for rejection of claims 3, 5 are applied.

16. Re. To claim 7: The method of claim 5 further comprising:

- said removable storage medium **remains with a consumer;** this limitation is already discussed in claim 6; therefore similar rationales are applied.

17. <u>Re. To claim **8**</u>: The method of claim 5 further comprising:

- **prior to validating** the e-receipt, selecting one of e-receipts in **accordance with input** from a consumer.

The Official Notice is taken that a step of selecting a specific receipt for validating **must be made because there were different e-receipts in a storage device.** Therefore, that step is obvious in said method.

18. <u>Re. To claim **9**</u>: The method of claim 5 wherein the e-receipt **may be** validated a number of times for a purchase transaction that requires a plurality of deliveries of goods/service (the use of "may be" means a possibility/option; it can be interpreted as "at least once". However, the Official Notice is taken here that if there are many validations the step of validating a receipt is still obvious (e.g., a purchased device having several different components: an amplifier set, a DVD/DC player, surround sound speakers .etc. if the store is missing a speaker, then the purchase is still went thru. With a later pick-up of that missing speaker; when a customer picks-up that missing speaker, another validating of e-receipt must be made).

19. <u>Re. To claim **10/11**</u>: The method of claim 5 wherein the e-receipt "may be" **validated for** a claim for **servicing of a product** subject to the purchase transaction.

The Official Notice is taken that for the purpose of later servicing a product, original receipt must be provided whether it is a regular receipt or an e-receipt; therefore, this limitation is obvious to one of skill in the art.

20. <u>Re. To claim **11** (as claim 10)</u>: The method of claim 5 wherein the e-receipt **may be** validated **for** a warranty claim on goods/services subject to the purchase transaction. The examiner submits a similar rationale as for claim 10.

21. <u>Re. To claim **12/29**</u>: The method of claim 5 wherein the removable storage medium is a smart card.

The examiner submits that a smart card (i.e., a credit card that contains an IC circuit that gives it a limited amount of "intelligent" and memory) or a floppy disk or a safe card are obviously classified as removable storage medium.

22. <u>Re. To claim **13**</u>: The method of claim 5 wherein the removable storage medium is an optical card.

The examiner submits that an optical card (**i.e., a compact disk**) or a floppy disk are obviously classified as a removable storage medium.

23. <u>Re. To claims **14/26**</u>: The method of claim 5 wherein the step of validating the electronic receipt further comprises **inspecting a digital signature** to **verify the integrity of that e-receipt**

The examiner submits that a step of validating/checking/(verifying the integrity) obviously may means **inspecting a digital signature** of said document because that is one of **requirements)**.

The examiner submits similar rationale for claim 26 although it claims a program product.

24.   <u>Re. To claims **15-24**</u>: These claims were canceled on 9/14/2001.

25.   <u>Re. To claim **25**</u>: A computer program product in a computer-readable medium for conducting a commercial transaction, the computer program product comprising:

- 1st instructions for **recording an e-receipt on a removable storage medium** at a 1st computer, the e-receipt comprising data concerning a commercial transaction (obvious limitation - not inventive);

- 2nd instructions for **reading the removable storage medium** after its receipt at a 2nd computer (obvious limitation - not inventive);

- 3rd instructions for **validating the e-receipt** stored on the removable storage medium at the 2nd computer (obvious limitation - not inventive); and

- 4th instructions for **providing authorization for** conducting a commercial **transaction** in response to validating the e-receipt (obvious limitation - not inventive).

The examiner submits similar rationales as in claim 1 although it claims a program product.

26.   <u>Re. To claim **26** (as claims 4, 14)</u>: The computer program product of claim 25 wherein the instructions for **validating the electronic receipt** further comprise instructions for **inspecting a digital signature** to verify the integrity of the electronic receipt. The examiner submits that instruction for validating an e-receipt analogous to inspecting a signature.

The examiner submits similar rationales as in claim 4 although it claims a program product.

27.   <u>Re. To claim **27/37**</u>: A computer program product in a computer-readable medium for processing an e-receipt, the computer program product comprising:

- 1st instructions for processing a purchase transaction;

- 2nd instructions for generating an e-receipt comprising data concerning the purchase transaction;

- 3rd instructions for storing the e-receipt on a removable storage medium;

- 4th instructions for reading the e-receipt on the removable storage medium;

- 5th instructions for validating the e-receipt; and

- 6th instructions for providing an indication to proceed with a delivery of goods/services related to the purchase transaction in response to validating the electronic receipt.

Besides similar limitations with claim 27; claim 37 further having:

- 7th instructions for **updating an inventory** in response to validating the e-receipt.

This claim 's limitations are obvious by analogy to the limitations of claims 3/5. Therefore, similar rationales and references for those claims are applied.

28. <u>Re. To claim **28**</u>: The computer program product of claim 27 wherein the instructions for validating the e-receipt further comprise instructions for **inspecting a digital signature** to verify the integrity of that e-receipt.

This claim 's limitations are obvious by analogy to the limitations of claim 14. Therefore, similar rationales and references are applied.

29. <u>Re. To claim **29** (as claim 12)</u>: The method of claim 1, wherein said removable storage media is a safe card, The examiner submits that a smart card can be considered as a safe card; therefore, Therefore, similar rationales and references using in claim 12 are applied.

30. <u>Re. To claim **30**</u>:(as claim 12): The method of claim 1, wherein said removable storage media is a smart card (similar rationales and references using in claim 12 are applied).

31. <u>Re. To claim **31**</u>: The method of claim 1, wherein **each portion of said removable media can only be written once** (The examiner submits that the ability to write on the track of a media only one time have been widely used in industry; e.g., in electronic communications have been widely used

PROM (programmable read-only-memory) chips, wherein that

memory media is only been programmed once and cannot be

reprogrammed).

32. Re. To claim **32/5**: The method of claim 1, wherein said

reading step is performed ~~to delivery of goods/services~~

~~previously paid for~~. (The examiner submits that this claimed

step (reading a store's receipt) has been done and it is not

patentable).

33. Re. To claim **33/5**: The method of claim 1, wherein that

reading step is performed to verify warranty granted. (The

examiner submits that this claimed step (reading a store's

receipt) has been done and it is not patentable).

34.Re. To claim **34**: A method of processing a receipt,

comprising the steps of:

- **conducting a new transaction which is affected by said**

previous transaction (e.g., exchanging a previously

purchased TV);

- **updating said 1st e-receipt** to reflect said new

transaction. The examiner submits that updating a receipt

has been widely practiced in marketing. Therefore, instead

of a regular receipt, an e-receipt takes place knowing that

e-receipt existed before the time of this pending invention.

35.Re. To claim **35**: The method of claim 34, wherein said

updating step overwrites said 1st e-receipt and writes a 2nd,

updated e-receipt. The examiner submits that this

fundamental step to updating a receipt has been widely used in business; therefore, this step is not inventive.

36.Re. To claim **36**: The method of claim 34, wherein said updating step writes a 2nd e-receipt reflecting said new transaction and **places a pointer in said 1st e-receipt which points to said 2nd e-receipt.** The examiner submits that the MS Computer Dictionary (3rd edition, 1997) did defines a use of a pointer; pointer: a variable that contains the memory location (address) of some data rather than data itself; therefore the above step for updating e-receipt using pointer was self-explained before the pending invention date.

37.Re. To claim **37**: A computer program product in a computer readable medium for processing an e-receipt, the computer program product comprising:

- 1st instructions for processing a purchase transaction;

- 2nd instructions for generating a 1st e-receipt comprising data concerning the purchase transaction;

- 3rd instructions for storing said 1st e-receipt on a removable storage medium;

- 4th instructions for reading said 1st e-receipt from the removable storage medium;

- 5th instructions validating said 1st e-receipt; and

- 6th instructions for **modifying said 1st e-receipt.**

The examiner submits that it was obvious to one with programming skill in the art to write above instructions using rationales and references of claim 27.

38.Re. To claim **38**: The method of claim 37, wherein said 6th instructions **overwrite** said 1st e-receipt and write a 2nd, updated e-receipt. The examiner submits that this step has been widely used in business for updating a receipt; e.g., a customer brought back a product to exchange for a different product within an allowable exchange period; then the salesman issued an updated receipt.

39.Re. To claim **39**: The method of claim 37, wherein said 6th instructions **write a 2nd e-receipt** reflecting said new transaction and **places a pointer in said 1st e-receipt which points to said 2nd e-receipt.** The examiner submits that this step is analogous to putting a remark (in 1st receipt) to remind a relationship between 1st & 2nd receipts; the use of a pointer to do this task has been known to one with programming skill in the art.

40.Re. To claim **40 (same as in claims 6)**: The method of processing a receipt, comprising the steps of:

- storing an e-receipt for said commercial transaction on a computer-readable media (e.g., smart-cards), wherein said **e-receipt contains additional information beyond that given to document the transaction (e.g., those additional info. can be type, model, year made, serial number of a product;** these above information are well-known for one with skill in the art); and

- giving said computer readable media to a customer; this limitation is obvious with above rationales.

41.Re. To claim **41**: The method of claim 40, wherein said additional info. is **a credit card number which causes an extended warranty to be in effect.** This step has been analogously used in business: if you buy an air ticket and use your credit card, the credit card company also covered for the life insurance of you in case there is an accident for you that happening in that flight. This limitation is not patentable.

42.Re. To claim **42**: The method of claim 40, wherein said **additional information is installation guidelines** for a product purchased in said commercial transaction (when a customer buy a satellite disk, and a self-installation instruction booklet would be provided and this info. has been considered as booklets was provided and written in a receipt as evident; because of this reasoning the examiner submits that this limitation is not patentable).

43.Re. To claim **43**: A computer program product in a computer-readable medium for processing an e-receipt, the computer program product comprising:

- 1st instructions for processing a purchase transaction;

- 2nd instructions for generating an e-receipt comprising data concerning the purchase transaction; and

- 3rd instructions for storing said e-receipt on a removable storage medium (a smart-card) along with **additional information** beyond that given to document the transaction (note: additional information can be interpreted as just information).

The examiner submits that this claim's limitations have been considered in claims 3, 42 and 40; therefore, similar rationales and references for rejections are applied.

44.Re. To claim **44**: The method of claim 43, wherein said **additional information is** a **credit card number** which causes an extended warranty to be in effect. The examiner submits that similar rationale and references for rejecting claims 41 are applied.

45.Re. To claim **46**: The examiner submits that besides limitations as in claim 27, the **data stored is in encrypted form.**

The Official Notice is taken here that above analogous feature has been done.

46.Re. To claim **45**: The examiner submits that besides limitations as in claim 27, the **data stored is in encrypted form although claim 45 is a method claim.**

And "whereby consumer tampering with said receipt is prevented" the examiner submits that it is very obvious that "consumer tampering with said receipt is prevented" from encryption already; therefore, this limitation is not patentable.

In summary, all the claims are directed to the use of e-receipt stored on a computer-readable medium (smart-card) for transactions wherein all claims' limitations can be found in the US patents of Tognazzini (US Pat. 5,739,512), Vaghi (US Pat. 6,047,273), Beatson et al., (US Pat. 5,892,824), and Muftic (US Pat. 5,850,442), or very obvious

with capacities of smart-cards at the time of invention. In
the cited disclosures, the inventors utilized e-receipts and
did validating them for different purposes.

The Official Notice is further taken here that these
concepts are also notorious well-known in the art:

- processing steps for processing a transaction;

- generating steps for generating e-receipts for above
transaction;

- storing steps for storing said e-receipts;

- reading steps for reading said e-receipts;

- validating steps for validating said e-receipts;

- indicating steps for providing an indication to proceed
with a delivery of related goods/services;

- inspecting steps for inspecting a digital signature of
said e-receipts.

The examiner submits that all claimed limitations are
so obvious or well-known in the art, one reason is because
these claimed limitations are very broad that they are
easily recognized by artisan in the art to be
ability/features/components of a computer system and said
components would perform claimed tasks/steps; cited prior
art's limitations are not necessary spelled-out exactly
claimed languages, because cited prior art is also directed
to a similar process/system for communicating between
sellers and buyers through e-receipts as a convenient way,
paperless transaction, improving accuracy by using past
history and security techniques. It is reasonable that

various modifications and variations of the described method

or system of the cited prior art would be apparent to those

skilled in the art without departing from the scope and

spirit of the invention. Although cited disclosures have

been described in connection with specific preferred

embodiments, it should be understood that their subject

matter should not be unduly limited to such specific

embodiments.

Conclusion

47.All pending claims are rejected.

48. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final

action is set to expire THREE MONTHS from the mailing date

of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the

advisory action is not mailed until after the end of the

THREE-MONTH shortened statutory period, then the shortened

statutory period will expire on the date the advisory action

is mailed, and any extension fee pursuant to 37 CFR 1.136(a)

will be calculated from the mailing date of the advisory

action. In no event, however, will the statutory period for

reply expire later than SIX MONTHS from the date of this

final action.

49.

- Business Wire, Feb 11, 1999; RPK Security Selected to

Provide Encryption Solution for Electronic Payment Systems

and Smart Card Readers. (claim 46)

- **Digital signature reaches new level.**(Bank of Nova Scotia

uses Entrust Technologies' public key infrastructure

software) (Company Operations)

Author/s: Greg Meckbach. Issue: June 22, 1998

- **Trotta**, Jr., (US Pat. 5,595,264), System and method for

automated shopping - 1/21/1997; wherein a system and method

of automated shopping, including a portable bar code scanner

for scanning bar code indicia information on items selected

to be purchased, securing the scanner in a holder for

limited access, and releasing the portable bar code scanner

upon receiving an authorized payment card. A plurality of

items for purchase are displayed in a store such that a

customer can select an item to be purchased from the store

display. The customer scans the bar code indicia on the

selected item from the store display. The payment card is

debited for the purchase price of the selected item and then

returned to the customer.

- **Kitagawa** et al. (US Pat. 6,032,857 - 8/23/1994) Electronic

money system wherein an electronic money system has an IC

card for electronic money having a memory for maintaining

money deposit and money debit information and another

memory, such as an EPROM, for storing transaction data,
including detailed information of transactions, such as the
content of a typical receipt received from a retail store.
The transaction information can be used at a later time in a
personal computer so that an electronic record of household
expenses can be maintained The transaction data that is
stored includes the product name, price of the product,
quantity of the product purchased and similar details of the
transaction. The IC card memory can record the name and
telephone number of a retail store where the card has been
used or a network address can be recorded in the memory for
use by a customer to access electronic direct-mail
information by using a PC. Also, a store can determine
whether a particular purchase is within a range of average
purchases in terms of the number of products being purchased
in a transaction and the total cost of the transaction,
based on the stored transaction information.

50. The examiner uses these US Patent case laws in this
examination:
A.   The examiner submits that the reasons for rejection are
obvious (v.s. cited prior arts) with **claims' language**. In
re **Mraz**, 59 CCPA, F.2d, 173 USPQ 25, 28 (1972), the court
ruled: "Claims which are broad enough to read on obvious
subject matter are unpatentable even though they also read
on nonobvious subject matter".

B.Note About Treatment of Combined References:

In re **Keller, Terry, and Davies**, 208 USPQ 871 (CCPA 1981), the court rules: "One cannot show non-obviousness by attacking references individually where rejections are based on combinations of references."

C.   In re **Merck & Co., Inc.**, 231 USPQ 375 (CA FC 1986), the court rules: "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references."

D.   "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

E. **Lamont v. Berguer**, 7 USPQ2d 1580 (BdPatApp&Int 1988) Section 103 requires us to presume that the artisan has full knowledge of the prior art in his field of endeavor and the ability to select and utilize knowledge from analogous arts.

51. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:15 AM-3:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703)308-1344.

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to: (703) 746-7238 (after Final)

(703) 746-7239 (Official)

Or: (703) 746-5572/746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT") Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA. 22202, 4th. Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

Cuonghnguyen
Primary Examiner
November 27, 2001